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Official

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Adam T. Lee, et al.)
)
Serial No. 08/811,434)
)
Filed: March 3, 1997)
)
DOWNCOMER FOR CHEMICAL)
PROCESS TOWER)

Attorney Docket No. KOCH.56145

Examiner: Bushey, C.

Art Unit: 1724

FAX RECEIVED

JAN 26 1999

GROUP 1700

RESPONSE UNDER
37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP
1724

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Office Action dated December 11, 1998, Applicant requests reconsideration of the application.

Applicant notes with appreciation the indication that claims 35-37 are considered to be allowable over the prior art of record, with the exception of copending application Serial No. 08/742,819.

Claims 35-37 stand rejected under 35 U.S.C. § 102(b) based upon a prior offer for sale more than one year prior to the March 3, 1997 filing date of the present application. Applicant has established, in its prior response filed December 1, 1998, that the invention was not placed on sale more than one year prior to the October 20, 1996 filing date of parent application Serial No.

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08/742,819. In support of the rejection, however, it was stated that the present application is not entitled to the filing date of the parent application because the inventive entities in the respective applications are not identical.

The invention as now claimed in the present application is entitled to the filing date of its parent application in accordance with 35 U.S.C. § 120, because (1) the invention was fully disclosed in the parent application, (2) the present application was filed by inventors named in the previously filed application, and (3) the present application has been amended (in the amendment filed December 1, 1998) to contain a specific reference to the earlier filed application. This result is dictated by the plain language of the statute, as well as precedent from the Federal Circuit Court of Appeals. In *In re Chu*, 36 U.S.P.Q. 2d 1089 (Fed. Cir. 1995) (J. Rich), the availability of an earlier patent to Doyle as prior art against a CIP application to Chu was at issue. The Board had earlier found that Chu was not entitled to the benefit of the Doyle patent filing date because the inventive entities, although overlapping, were not identical. The Federal Circuit, however, held that the 1984 amendment to § 120 allows continuation-in-part applications to be afforded the filing date of the parent application even though there is not complete identity of inventorship between the parent and subsequent applications. Judge Rich, writing for the panel, stated:

Thus, the Board erred in requiring complete identity of inventorship between the Doyle patent and the Chu application in order for Chu to have the benefit of the Doyle patent's filing date. There is overlap in the inventive entities of the Doyle patent and the Chu application, which, after the 1984 amendment, is all that is required in terms of inventorship or "inventive entity" to have the benefit of an earlier filing date. *Id.* at 1093 (emphasis added).

Date: 1/26/99
Pages: 7
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Type: Fax NO. 7487 P. 4/7

The Federal Circuit ultimately concluded that Doyle was a proper prior art reference, because it did not disclose and failed to provide support for the subject matter that was subsequently claimed by Chu.

As was the case in *Chu*, there is overlap in the inventorship of the present application and its parent application, thus satisfying the common inventorship requirement under § 120. Unlike *Chu*, however, the claims in the present application are also fully supported by the parent application. Indeed, this was conceded at page 3 of the most recent Office Action wherein it was stated that "the subject matter of claims 35-37, as now present in the instant application, finds full support in the disclosure of copending application 08/742,819." As a result, the presently claimed invention is entitled to the benefit of the October 20, 1996 filing date of the parent application, thereby overcoming the rejection under 35 U.S.C. § 102(b).

Claims 35-37 also stand provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by parent application Serial No. 08/742,819. This basis of rejection is respectfully traversed because § 102(e) requires that the invention be described in an application filed in the United States before the invention thereof by the applicant for patent. Because the invention of claims 35-37 in the present application is entitled to the filing date of the parent application, the parent application cannot constitute an application filed before the invention of claims 35-37. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(e) is requested.

Claims 35-37 also stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-26 of copending application Serial No. 08/742,819. This basis of rejection is respectfully traversed because claims 35-37 of the present application are patentably distinct from those claims presented in the parent application. However, in an attempt to facilitate

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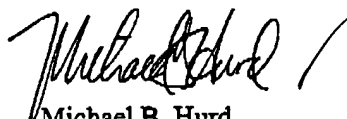
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Pages: 7
Fax Number:
Company: JAN. 26. 1999 2:52PM

Time: 3:49 PM
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Subject:
Type: Fax NO. 7487 P. 5/7

allowance of the present application, and without any admission that the presently claimed invention is an obvious variation of the invention claimed in the parent application, applicant submits herewith a terminal disclaimer to overcome the double patenting rejection.

It is believed that entry of this response will place the application in proper condition for allowance and such favorable action is respectfully requested. If the Examiner should feel that a telephone interview would facilitate resolution of any remaining issues, he is asked to contact the undersigned at the number indicated below.

Respectfully submitted,


Michael B. Hurd
Reg. No. 32,241

January 26, 1999

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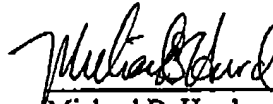
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing RESPONSE is being transmitted to the United States Patent and Trademark Office on this 26th day of January, 1999 via facsimile transmission.



Michael B. Hurd
Reg. No. 32,241